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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/615,351

Applicant(s)

ZADROZNY ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-14, 16-23, 46, 48-56, 82, 88 and 89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-14, 16-23, 46, 48-56, 82, and 88-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on July 17, 2007 wherein claims 1, 4-14, 16-23, 46, 48-56, 82, and 88-89 are currently pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 17, 2007 has been entered.

Response to Amendment

3. The declaration filed on July 17, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Mayer reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Mayer reference.

First, the declaration itself has several defects. Statement 5 states that the invention disclosure document provided as Exhibit A hereto was completed at least before April 17, 2007, which is earlier than the effective filing date of Mayer. Mayer has a filing date of 2000, not 2007. Secondly, MPEP 715.07(c) sets forth that the 37 CFR 1.131 affidavit or declaration must contain an allegation that the acts relied upon to

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establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country.

MPEP 715.02 states that:

715.02 How Much of the Claimed Invention Must Be Shown, Including the General Rule as to Generic Claims

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. *In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965).

Further, a 37 CFR 1.131 affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s) or the identical subject matter involved in the activity relied upon. If the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference or activity, the affidavit or declaration is sufficient, whether or not it is a showing of the identical disclosure of the reference or the identical subject matter involved in the activity. See *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

E I. SWEARING BEHIND ONE OF A PLURALITY OF COMBINED REFERENCES

Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. However, as discussed above, applicant's 37 CFR 1.131 affidavit must show possession of either the whole invention as claimed or something falling within the claim(s) prior to the effective date of the reference being antedated; it is not enough merely to show possession of what the reference happens to show if the reference does not teach the basic inventive concept.

MPEP 515.07 states that:

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." *In re Asahi /America Inc.*, 68 F.3d 442, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995) (Citing *Newkirk v. Lulejian*, 825

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F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

The Examiner asserts that the applicant has failed to establish proof of actual reduction to practice. The evidence submitted is not enough to establish conception of the claimed invention, much less reduction to practice.

Claim Rejections - 35 USC § 112

4. Claim 88 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant has added claim 88 which contains the following language:

***determining by the first computing device a confidentiality level
for the proposal for inventions***

The above subject matter has not been described in the specification in such a way as to enable one skilled in the art to make and/or use the invention without undue experimentation.

***Applicant states on page 3 of the response to arguments
submitted on July 17, 2007 that it is the proposal for inventions for
which a confidentiality level is determined and that the Examiner is***

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confusing the "confidentiality level for the proposal for inventions" with other confidentiality levels described in the specification and recited in the claims. Applicant again directs the Examiner to page 30, line 11 thru page 31, line 21 (which applicant also directed the Examiner to in the response submitted on January 16, 2007) which reads:

Returning to FIG. 3, after the initial inventor 100 inputs the appropriate information in the Patent Proposal Input Web page, the input information is transferred over the secure network 155 to the Patent Proposal database 112. At this point, the Patent Proposal Database Server 112 creates a Patent Proposal Database Record for this patent proposal. The Patent Proposal Database Server 112 is responsible for understanding the requirements sent by the initial inventor 100 and choosing which users to solicit with the patent idea. The Patent Proposal Database Server 112 uses the co-inventor requirements and patent proposal description to help select a solicitation list of possible co-inventors. ***The Security System 150 establishes a confidentiality level for each Patent Proposal record in the Patent Proposal Database Server 112, by determining the importance of the idea. The "importance" of an idea may have different meanings, depending on the corporation or entities involved. For instance, it may mean economic gain, level of need for that proposed idea in the corporation, and it may depend on other issues, such as whether or not the corporation is working with other corporations in the same area.***

The Security System 150 may have a central processing unit (CPU) which uses a heuristic analysis program to weigh these factors and determine an appropriate confidentiality level. On the other hand, the Security System 150 may analyze the data and present a report to a patent proposal committee or patent proposal manager, who determines the appropriate level of confidentiality based on their knowledge of the situation and contact with other managers in the corporation. In short, the Security System 150 represents any type of system, computer or human, which designates a confidentiality level for a patent proposal.

The Examiner asserts that this disclosed subject matter does not enable one skilled in the art to make or use the invention without undue experimentation. The levels of confidentiality have not been identified. The

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criteria for determining the levels of confidentiality have not been identified.

What is an appropriate confidentiality level? How is this determined? What information is used to determine the confidentiality level?

5. Claims 1, 4-14, 16-23, 46, 48-56, and 82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant has amended the claim language to include the following:

said subscriber qualifications including information related to at least one of a total number of drafting hours, proposals, drafts, and issued patents corresponding to a subscriber and

said desired co-inventor qualifications including information related to at least one of a total number of drafting hours, proposals, drafts, and issued patents corresponding to a desired co-inventor.

Starting on page 20 of the specification the applicant discloses the following:

After the employee enters the login information, she is presented with a Co-Inventor Subscription Web page, as shown in Figure 5.

The specification then list the numerous amounts of information that can be entered on pages 19 through 24 of the specification.

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Page 24 of the specification states that *once these fields are filled, the Subscriber Database record is complete and stored in the Subscriber database 114.*

On page 28 of the specification the applicant discloses that *under "Co-inventor Requirements" in FIG. 6, are the requirements used to search the subscriber database to create the potential co-inventor pool.*

The specification goes on to state:

Under "Co-Inventor Requirements" in FIG. 6, are the requirements used to search the subscriber database to create the potential co-inventor pool. The "Level of Confidentiality" field stores the level of confidentiality determined by the Security System 150. In this example, the confidentiality levels are internal, confidential, and top confidential. However, there may be many more gradations and conditions in the confidentiality levels. The initial inventor can not modify this field. The "Area(s) of Expertise" field indicates the areas desired by the initial inventor. The "Technical Skills" field indicates what special skills or experience might be needed to assist in drafting the patent, such as a medical specialization. The "Education" field can indicate a level of education, type of education, or whether particular course or subjects were taken.

Page 29 of applicant's specification discloses:

Most of these fields, except "Level of Confidentiality", are filled in by the initial inventor in the preferred embodiment. In other embodiments, certain fields might be set by a patent proposal committee or patent proposal manager in order to ensure uniformity of style and that frivolous proposals are not made to subscribers. In yet other embodiments, all of the co-inventor qualifications could be determined by the corporation after the initial inventor submits the patent proposal. In further other embodiments, a patent proposal committee or patent proposal manager may give a final edit to the proposal before it is saved to the Patent Proposal database. Furthermore, the different fields could be

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weighted by their relative importance. For instance, if the "Technical Skills" were more important than the "Writing Ability" for this particular patent proposal, there would be additional fields applying weighing factors to the corresponding fields.

Returning to FIG. 3, after the initial inventor 100 inputs the appropriate information in the Patent Proposal Input Web page, the input information is transferred over the secure network 155 to the Patent Proposal database 112. At this point, the Patent Proposal Database Server 112 creates a Patent Proposal Database Record for this patent proposal. The Patent Proposal Database Server 112 is responsible for understanding the requirements sent by the initial inventor 100 and choosing which users to solicit with the patent idea. The Patent Proposal Database Server 112 uses the co-inventor requirements and patent proposal description to help select a solicitation list of possible co-inventors.

The Patent Proposal Database Record Formatter 720 receives the decrypted patent proposal file 704 and the confidentiality level, and combines the decrypted patent proposal input file, the confidentiality level, and other information into the appropriate record format of the Patent Proposal Database Server 112. This newly-created patent proposal database record 735 is sent to the Co-Inventor Solicitor 740, which selects potential co-inventors and solicits them. The Co-Inventor Solicitor 740 searches the Subscriber Database 114, and selects potential co-inventors using the co-inventor characteristics in the patent proposal database record 735. After searching the Subscriber database 114, the Co-Inventor Solicitor 740 searches the non-Subscriber Database 116 for potential co-inventors, using nominal characteristics from the patent proposal database record 735, such as "Technical Skills", "Education", etc. The Co-Inventor Solicitor 740 generates the co-inventor pool from these two searches and appends it to the database record 735.

Applicant states in the response submitted on July 17, 2007 that page 19, lines 18-20 states that an employee indicates their willingness to be a co-inventor.

Applicant then states that any information entered for an employee is the information for a co-inventor. Applicant states that therefore, any information enter for an employee is the information for a co-inventor, as the employee has now been indicated as a co-inventor.

The Examiner asserts that while there is disclosure for the subscriber/employee entering information relating to total number of drafting hours, proposals, drafts, and issued patents, there is not adequate support for co-inventor qualifications including information related to at least one of a total number of drafting hours, proposals, drafts, and issued patents. Thus, this is amended claim language is new matter.

The applicant directs the Examiner to page 22, line 11 and Figures 4-5. As set above, the Examiner does not find support for the limitation as set forth by the applicant in the claim language. Page 20 of the specification sets that after the employee enters the login information, she is presented with a Co-inventor subscription web page as shown in Figure 5. The specification states that none of these fields would be accessible (i.e. changeable) by the employee. Some fields, such as "Patents", "Proposed", "Co-Invented", "No of Years" and "No. of Hours", would automatically generated. Other fields, such as "Writing Ability" and "Teamwork" would require some sort of assessment.

Page 23 of the specification discloses:

On the right-hand side of the Co-Inventor Subscription Web page, under "Subscription Data" 530 as shown in FIG. 5, are the fields that the employee enters herself. The first field "Area(s) of Expertise" allows the employee to list what she believes her areas of expertise. This is allowed in the preferred embodiment because another person with access to this record could view the employee's work history, technical skills, and education in order to assess the

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employee's claims of expertise. If the employee wishes, she may explain why those are her areas of expertise in the same field. The second field "Area(s) of Interest" allows the employee to indicate what area she wants to be further involved in. Putting a category like "Opto-Electronic Switches" in this field guarantees that, if the employee fulfills the other categories, the employee will be placed in the co-inventor pool for patent proposals involving opto-electronic switches. The third field "Level of Commitment" allows the employee to indicate how much time she is willing to expend as a co-inventor. This field could be highly detailed, supplying vacation times and differing numbers of hours for different weeks, or fairly vague, supplying a total number of hours for the whole project. In addition, the "Level of Commitment" could supply different amounts of time depending on the type of project.

Once these fields are filled, the Subscriber Database record is complete and stored in the Subscriber database 114. The records in the Subscriber Database 114 have many of the same fields as the non-Subscriber Database records, as shown in FIG. 4, but also has many additional fields, such as the fields under "Patent Experience" and "Subscription Data" in FIG. 5.

Thus, as noted by the Examiner in the previous Office action, while there is disclosure for the subscriber/employee entering information relating to total number of drafting hours, proposals, drafts, and issued patents, there is not adequate support for subscriber/co-inventor qualifications including information related to at least one of a total number of drafting hours, proposals, drafts, and issued patents. Thus, the Examiner asserts that this amended claim language is new matter.

6. Claims 52-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant has amended the claim language to add in the following language:

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creating by a first computing device a subscriber list, said subscriber list comprising records, each of said subscriber records having at least a subscriber name, subscriber contract information, and subscriber qualifications, said subscriber qualifications including information related to at least one of a total number of drafting hours, proposals, drafts, and issued patents corresponding to a subscriber.

Applicant states in the response to arguments submitted on July 17, 2007 that page 19, lines 18-20 states that an employee subscribes, i.e. is a subscriber. Therefore, any information entered for an employee is the information for a subscriber, as the employee has now subscribed.

Examiner has reviewed applicant's disclosure and submits that the added limitation of the subscriber qualifications including information relating to at least one of a total number of drafting hours, proposals, drafts, and issued patents is directed to new matter.

The Examiner finds support for the records to be stored in a database. However, there is no disclosure of the list containing all of this information.

In the Remarks submitted on January 16, 2007, the applicant directs the Examiner to page 22, line 11 and Figures 4-5 as providing support for these limitations. This section of the specification has been presented above.

Page 6 of the applicant's specification discloses:

To accomplish the above and other objects, a method is proposed, which, in the preferred embodiment, comprises the steps of creating a subscriber list; receiving a proposal of a patent idea by an initial inventor; creating a pool of potential co-inventors by searching through the subscriber lists; providing a forum

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for the pool of potential co-inventors and the initial inventor to communicate and further develop the patent proposal

As set forth above in the rejection as to claims 1, 4-14, 16-23, 46, 48-56, and 82 above, the Examiner asserts that while there is support gathering or providing information relating to total number of drafting hours, proposals, drafts, and issued patents, there is not support for the subscriber qualification including this information.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 89 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant added new claim 89 in the amendment submitted July 3, 2006, wherein the claim reads:

The method as recited in claim 1 further including:

collecting bids; and

displaying information related to the collected bids using at least one of a pie chart and graph.

It is not clear who is bidding or what the bidding is for. Are the bids collected from co-inventor, subscribers, or some outside source, such as some company having a vested interest in the potential invention? Claim 1 is directed to a method for supporting

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the development of inventions by creating a pool of co-inventors by searching a database and matching qualifications, wherein the pool of co-inventors are provided a forum to further develop the proposal. Therefore, do the co-inventors bid on the proposal even though it is undeveloped? Are do companies with a vested interest in the proposal bid to supply funding for the project? It is not clear who is bidding, what one is bidding on, or who is collecting the bidding?

Thus, the Examiner asserts that it is unclear how the bidding is related to the rest of the steps in claim 1?

The Examiner notes that the applicant provided no arguments as to this rejection in the response submitted on July 17, 2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14 and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al (US 2001/0034630) (hereinafter referred to as Mayer) in view of Takano et al (US 6434,580) (hereinafter referred to as Takano).

Regarding Claims 14,16 and 20:

Mayer discloses a system, the system comprising:

- a network of a plurality of computing devices (Figure 1 (10), [0004]; page 2 [0023]);
- a server for receiving information and for creating a pool (Figure 1 (12), page 3 [0037] page 5 [0082-0083]) ;
- a computing devices for transmitting information to the server over the network. (Figure 1 (20)(30), page 2 [0023] *Figure 1 depicts a computer network 10 through which remote devices 20,30 may communicate with one or more host servers 12*); and
- a database/file for storing records (profiles) (Figure 3A-3B; [0010];page 3 *server 12 stores a database program which maintains one or more databases such as candidate profile database and job profile database; [0057]*)
- wherein the server (12) is capable of sending a message to the pool over the network, matching criteria or qualifications and candidates; and creating (proposal/job profiles) files (Figure 4 job profiles (37), candidate profiles (36); [0037] *abstract - matching candidate information may be presented to the employer in response to a search query; Figure 4 Profile Matching Engine; page 1 [0010] provides an interactive employment system which allows a candidate to enter profile data and to match their criteria [0011] candidate can be contacted via an e-mail message or an instant message transmitted to the candidate's browser*);

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- wherein the server (12) creates a file (database of stored information) (page 3 [0037] *server stores a database program and maintains one or more databases such as candidate profile database (36) and a job profile database (37). The database program stores candidate profile data, job profile data and the like).*

The language for receiving a proposal for invention and for creating a pool of co-inventors from group of subscribers, is intended use of the system. A recitation directed to the manner in which a claimed system is intended to be used does not distinguish the claimed system from the prior art if the prior art has the capability to so perform. In the case, Mayer is fully capable of transmitting a proposal. The databases in Mayer are fully capable of storing subscriber records with a subscriber name, contact information, etc.

The language describing the type of information stored in the subscriber database does not distinguish the invention over the prior art. Claims directed to an apparatus/system must be distinguished from the prior art in terms of structure rather than function alone (See MPEP 2114). The Examiner has reason to believe that the system of Mayer is fully capable of storing all qualification information relating to at least one of a total number of drafting hours, proposals, drafts, and issued patents.

Mayer does not explicitly disclose a system structured and arranged for determining a confidentiality/access level for the invention, for maintaining records regarding the confidentiality/access level and authorizing access to the information.

However, Takano discloses a security system structured and arranged for determining a confidentiality/access level for the invention, for maintaining records regarding the confidentiality/access level and authorizing access to the information (col. 7, lines 13-26 fields for entering a piece of invention report information and file name including a reference number of draft data, an employee ID number etc; col. 8, lines 7-24 **displays on a display unit a list of all pieces of invention report information registered in this table 304 (or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department]; col. 10, lines 8-29 only those pertaining to the inventor concerned)** (The Examiner is interpreting the fact that only pieces of the invention report information satisfying specific conditions, e.g., only those pieces pertaining to inventors belonging to a department or displaying the report pieces to only those pertaining to the inventor concerned, as being as being an access/security system which authorizes access to information. The levels of access would be the granting of access to only those inventors belonging to a specific department, meaning that access levels are based on the department you are located in or, as set forth in column 10, lines 8-29, presenting pieces of inventor report information to an inventor based on the invention report information that concerns that inventor only is another level of authorizing access to information)

It would have been obvious to one of ordinary skill in the art to incorporate into the matching system of Mayer the draft data display of Takano so that only those

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persons satisfying specific conditions or only data pertaining to a particular inventor are displayed for the user.

The Examiner notes that claim 14 is directed to a system. Thus the fact that the security system is for maintaining records regarding confidentiality levels and authorizing access to secured information is the intended use of the system. The fact that the system is **structured and arranged** for doing something.

Functional Language

Because Applicants have elected in this case to pursue apparatus/system, Applicants are reminded that they are free to recite features of an apparatus/system either structurally or functionally. However, recitations of functional limitations carry a risk in that such functional recitations need not be directly disclosed to establish anticipation. As stated in *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997):

A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, . . . 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971)("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). Yet, choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 228:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. See also *In Re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); *In re Ludtke*, . . . 441 F.2d 660, 663-64, 169 USPQ 563, 565-67 (CCPA 1971).

In this particular case, Applicants have expressly recited in claim 14 that “a security system structure and arranged for. . . .” It is the Examiner’s factual determination that Takano discloses a computer system that provides a security system for authorizing access to information.

Furthermore, applicant states in the specification on page 31 that:

In short, the Security System 150 represents any type of system, computer or human, which designates a confidentiality level for a patent proposal.

Regarding Claim 17.

Takano discloses a system wherein the server (300) further comprises a means by which a user can access the file and a means by which a user can add data to the file (*col. 8, 25-32 pieces of invention report information displayed on the display unit; any desired piece of invention report information can be selected by entering the piece number; col. 10, lines 8-51 the inventor, if he or she finds it necessary to **modify** the revised draft data, modifies the revised draft data*).

Regarding Claim 18:

Mayer discloses a system further comprising:

a web server for providing at least one web page accessible over the network, said web page comprising a means to access and add data to a file over the network (Figure 1 (12); page 2 [0024] *server 12 maintains a web site which is hosted by the Internet. A candidate or employer communicates with the server through remote terminals (20, 30); page 3 [0043] host server 12 can direct any remote computing devices 20,30 to display*

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an appropriate interface such as one or more pre-formatted web pages so that a user can interact with the serve; [0045] data can be entered).

Regarding Claim 19:

Mayer discloses a system further comprising a computing device for transmitting information to a database (remote Terminals 20,30 and Network Connection (14), page 2 [0023] (Figure 1)).

Regarding Claim 21-23:

Mayer discloses a system wherein the server adds individuals to the pool by searching a database for a candidates that match qualifications and eliminates candidates that do not meet the qualifications (page 5 [0082][0083], *the server compares the search criteria to the candidate profiles stored in the database 36 and lists candidates who match the search criteria* (Figure 4 step 92) (Thus, those that do not match are eliminated or not listed).

The confidentiality level set forth in claim record is interpreted by the Examiner to be criteria used to make the match. Since claim 14 is directed to a system, the fact that the records also include a confidentiality level as a criteria is determined to be non-functional descriptive data and cannot render non-obvious an invention that would have otherwise been obvious. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.

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Cir. 1983). The data in the record does not alter the structure of the system or how the computer functions, i.e. matching criteria with qualifications.

9. Claims 52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over InoNet in view of Tadayon (US 2004/0249902) (hereinafter referred to as Tadayon) and further in view of Mayer et al (2001/0034630) (hereinafter referred to as Mayer).

Regarding Claim 52:

InoNet discloses method of providing support for the development of inventions of a plurality of inventors over a network, the method comprising the steps of:

- creating a list (page 4 from its database, InoNet chooses a group of 8-10 inventors; page 8 those who work in fields related to the problem participate; InoNet, in corporation with the client company, selects potential team members from the InoNet database of inventive people
- providing a secured forum on a network for a pool of potential co-inventors and an initial inventor to communicate and to further develop proposal for invention, (page 1 *virtual network of inventors world-wide, a place of collaboration and collective magic*; page 4 from its database InoNet chooses a group of 8-10 inventors; page 7 *conducted in a secure electronic environment*, page 8 *InoNet selects potential team members from the InoNet database of inventive people*), the proposal being submitted by a first client/inventor and including information

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relating to a proposal (page 4 *the client company provides a full, confidential description of the problem to be solved*), wherein at least one of the inventors in the pool develops a part of the invention (page 4 *from its database, InoNet chooses a group of 8-10 inventors to work on the problem*; page 5 *inventors may be able to offer patented solutions for the problem*).

InoNet does not disclose information being displayed according to a level of confidentiality.

However, Tadayon discloses a distributed file system which allows access to files by remote authorized users by using predetermined rules that enable the active virtual file system to be used in workflow automation [0012] which has an "Access Rights" function which inspects information previously store pertaining to this particular user (which could include a level of confidentiality) [0016] ([0001] *the invention is specifically disclosed as a web-based active virtual file system that controls the access rights of users to files stored on the server [0006] **once the user has been authenticated**, the file system 50 will determine what access rights this particular user will have [0070-0071] as in conventional network servers, virtually the first thing that must occur when a user initially communicates to a distributed file system is to determine whether or not the user has any right to be logged into the file system. Once the user has been property authenticated, this user's access rights must be determined and the WAVFS 150 uses an "Access Rights" function 162 for this purpose. The user's access rights are*

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represented by information that has been stored in the WAVFS 150 pertaining to this particular user). The Examiner asserts that the information stored could encompass a confidentiality level. The Examiner asserts that the fact that the user must be authenticated prior to accessing the system meets that claim limitation of wherein information is displayed according to a level of confidentiality. Tadayon discloses in paragraph [0070] that as in conventional network servers, virtually the first thing that must occur when a user initially communicates to a distributed file system is to determine whether or not that user has any right to be logged into the file system. Tadayon discloses in paragraph [0072] a User Management function and a Group Management function which allows the system administrator to add, delete, or edit users and their attributes and to group various users in predetermined ways using the Group Management function. Paragraph [0080] discloses that a user must enter his or her authentication information, components such as username and password, and a determination is made as to whether or not the authentication information is correct. Paragraph [0083] discloses that user interface information is presented based upon the user access level. (The Examiner interprets this as displaying information according to a level of confidentiality).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the problem solving service discloses in InoNet with the distributed file system access rights as taught in Tadayon to be able to monitor and control certain actions by users and to control the access rights of users to the files by determining

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whether or not the user has any right to be logged into the system and what rights the user has once authenticated.

InoNet discloses information relating to a proposal or problem to be solved. InoNet does not disclose creating a list comprising subscriber records, each record having at least a name, contact information, and qualifications.

However, Mayer discloses candidates entering profile data, including identification data, and employers/inventors searching profile data and returning results corresponding to candidates who match the criteria, wherein the search results can also withhold identification data, implying that identification data can also be supplied as disclosed in paragraph [0011], wherein portions of the profile data can be reviewed, such as previous job experience, positions held, education and the like [0010-0011].

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate into the innovator electronic network of InoNet the ability to create list with the profile records as disclosed in Mayer so that the employer/inventor can review a candidate's profile data when making a determination as to whether to employ the candidate and so that the employer can contact the candidate.

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Regarding Claim 53:

InoNet discloses a method wherein the step of providing a forum further comprises a step of providing at least one web page as the forum (InoNet is a website, *a virtual network of inventors using the intellectual power of the web to provide online problem solving sessions, this is the place for creativity, **collaboration** and collective magic;* page 1).

InoNet does not disclose the web page being stored on the server. However, Tayadon discloses a web-based active file system that controls access rights of users to files stored on the file server [0001].

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Tayadon with the collaboration disclosure of InoNet so as to provide a distributed file system that is web-based so as to allow remote users to use standard web browser software to access files in a central active virtual file system.

Regarding Claim 54:

InoNet discloses a method further comprising submitting a registration form to be included in databank of inventive people. Neither InoNet nor Tayadon disclose obtaining fees by a fee collection system.

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However, Mayer discloses obtaining fees by a fee collection system as shown in Figure 4 where the employer pays to unlock candidate identification and page 3 [0042] which identifies the web site host charging fees.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include obtaining fees as taught by Mayer with the collaboration disclosure of InoNet and Tayadon so as to generate revenue to run the job-placement web site business.

Regarding Claim 55:

InfoNet discloses a website for inventors which creates a pool of co-inventors (page 4 *from its database, InoNet chooses a group of 8-10 inventors*).

Neither InfoNet nor Tayadon disclose a fee collection system in which a fee is obtained from the initial inventor/company entitling the inventor to obtain information concerning the pool of potential co-inventors.

However, Mayer discloses the employer paying a fee to unlock the identification and contact data of the candidates (page 5 [0084])

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the payment of fees by the employer as taught by Mayer with the collaboration disclosure of InoNet and Tayadon so as to generate revenue on the basis

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of the number of qualified candidates that employers actually find through the use of the web site rather than charging for all candidates that match a particular job description so more employers will continue to use a job placement web site since the amount of money they are charged is proportional to the number of suitable and desirable candidates that the employer finds through the web site.

Regarding Claim 56:

InoNet discloses the secured forum is on the Internet (InoNet retrieved from the Internet Archive Wayback Machine)

10. Claims 1, 4-6, 8-13, 46, and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over InoNet in view of Mayer et al (US 2001/0034630) (hereinafter referred to as Mayer).

Regarding Claims 1 and 46:

Inonet discloses a method for supporting the development of inventions (InoNet offers an on-line problem-solving service for inventors and people working with intellectual property), the method comprising the steps of:

- creating, by a computing device, a subscriber list (page 1 *users register with InoNet* (subscriber) and are included in a *databank of inventive people*) comprising records having at least a name, contact information (see pages 9-13

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registration information includes name and contact information), and

*qualifications (pages 12-13 *Special Expertise and Education*);*

- storing said list in a database (page 1, InoNet is a databank of inventive people, page 4 from its database, InoNet chooses a group of 8 to 10 inventors) ;
- receiving, by the computing device a proposal (page 4 *technology, product, process or packaging problems are submitted*)
- The Merriam Webster online dictionary retrieved from Onelook.com defines a proposal as:

Main Entry: **pro·pos·al** ◄»

Pronunciation: pr&-'pO-z&l

Function: *noun*

1 : an act of putting forward or stating something for consideration

2 a : something proposed : **SUGGESTION** **b** : OFFER; *specifically* : an offer of marriage

The Examiner interprets submitting a problem needing a solution as an act of putting forward or stating something for consideration, i.e., a proposal. Furthermore, the applicant states on page 27 of the specification [t]he "**Problem Formulation**" field stores a short synopsis of the reasons or motivation for the patent idea. In order to make the system user-friendly, the **problem formulation** can have bullet categories to choose from, such as "a need for", "a lacking".

- creating, by the computing device a pool of co-inventors said information including information related to a proposal (page 4 the client company provides a

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full, confidential description of the problem to be solved; *InoNet chooses a group of 8-10 inventors from its database*) by searching for records in the list (*databank of inventive people*) with qualifications matching the desired co-inventor qualifications (see page 7 *the database of inventive people is scanned and a diverse team of highly qualified people are assembled*, page 8 *the potential team members are selected by InoNet in cooperation with the client company*), wherein said co-inventors in the created pool develop the invention described in the proposal (see page 3 - *problems (proposal) find solutions (invention)*).

- providing a forum for the pool of inventors to communicate and develop the proposal for the invention (page 1, *this is a place for creativity, **collaboration** and collective magic*; page 4 and page 7 *-the problem solving sessions takes place in a secure online environment*)

InfoNet does not disclose a step of contacting, by the computing device, the subscribers in the pool or that the list comprises records, each record having at least a subscriber name, subscriber contract information, and subscriber qualification, where the qualifications include information related to at least one of a total number of drafting hours, proposals, drafts, and issued patents, the step of submitting the desired qualifications or storing the desired qualifications in a database.

However, Mayer discloses

- the list comprising records, each record having at least a subscriber name, contract information, and qualification [0010-0011].

- a step of contacting by the computing device the subscribers (candidates) in the pool (page 1 [0011] *the candidate can be contacted via an e-mail message, an instant message transmitted to the candidate's browser, and the like*; also see page 4 [0047] and [0077])
- the step of submitting the desired qualifications (page 5 [0080] and [0081] *employer may then conduct a search for possible candidates for a job position by entering search criteria (qualifications)) and creating (submitting) a set of qualifications (page 3 [0037] server stores a database program which maintains one or more databases, such as a job profile database 37), page 5 [0080] a process by which an employer may submit job profile data*);
- the step of storing the desired qualifications in a database (page 3 [0037] *server 12 preferably stores a database program which maintains one or more databases, such as candidate profile database 36 and job profile database 37)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the submission of candidate profile information and the step of contacting candidates as taught by Mayer with the disclosure of InoNet since the Internet is being used to match job candidates and employers with increasing frequency and the system allows an employer to search profile data corresponding to a plurality of candidates and return results corresponding to candidates who match the search criteria with increased efficiency and speed, as opposed to a manual search, and to quickly notify the candidates without the candidates having to wait for a letter or fax.

Mayer discloses submitting job profile data [0080]. InoNet discloses the client company providing a full, confidential description of the problem to be solved. Neither discloses qualifications for a candidate to include drafting hours, proposals, drafts, and issued patents. However, parties/employers looking for candidates generally list qualifications in the field of their endeavor hoping to find the most qualified match. The more explicit the qualifications the more probable that the match a closer match will be achieved. For example, the qualifications listed for a doctor or a chef would be different than the qualifications listed for a mechanic. The qualifications for a pediatrician would be different from the qualifications listed for a surgeon. Therefore, a party looking for a person in the medical field would indicate the desired qualifications relating to a doctor, nurse, etc. If the party is looking specifically for a pediatric nurse, not a doctor, the party must submit as search criteria the qualifications that one would look for in a pediatric nurse. Thus, a party interested in developing a patent application would list qualifications pertinent to the field of intellectual property, more specifically, submitting and prosecuting a patent application.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the candidate/inventor match disclosed in InoNet and Mayer a list of qualifications including information about a candidates background and experience relating to patents since common sense dictates that a person who has hours of experience in drafting a patent application or who has actually gone through the process of having a patent issued will be more effective and efficient as a co-inventor/employee.

Neither InoNet nor Mayer disclose determining a confidentiality/access level for the proposal or wherein information is provided in the forum according to a level of confidentiality/access.

However, Tadayon discloses a distributed file system which allows access to files by remote authorized users by using predetermined rules that enable the active virtual file system to be used in workflow automation [0012] which has an "Access Rights" function which inspects information previously store pertaining to this particular user (which could include a level of confidentiality) [0016] ([0001] *the invention is specifically disclosed as a web-based active virtual file system that controls the access rights of users to files stored on the server [0006] once the user has been authenticated, the file system 50 will determine what access rights this particular user will have [0070-0071] as in conventional network servers, virtually the first thing that must occur when a user initially communicates to a distributed file system is to determine whether or not the user has any right to be logged into the file system. Once the user has been property authenticated, this user's access rights must be determined and the WAVFS 150 uses an "Access Rights" function 162 for this purpose. The user's access rights are represented by information that has been stored in the WAVFS 150 pertaining to this particular user*). The Examiner asserts that the information stored could encompass a confidentially level.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the problem solving service discloses in InoNet with the distributed file system access rights as taught in Tadayon to be able to monitor and control certain actions by users and to control the access rights of users to the files by determining whether or not the user has any right to be logged into the system and what rights the user has once authenticated.

Regarding Claim 48:

InoNet discloses a method further comprising providing, by the computing device, a forum for the pool to communicate and to further develop the proposal (page 1, *this is a place for creativity, **collaboration** and collective magic*; page 4 and page 7 *-the problem solving sessions takes place in a secure online environment*)

Regarding Claim 4.

InoNet discloses a method wherein the proposal is transmitted over the network (page 1 InoNet, *The Innovator's Electronic Network*, page 7 *the problem solving sessions takes place in a secure online environment*).

Regarding Claim 5.

InoNet does not disclose a method wherein the step of creating a pool is performed by a server.

However, Mayer discloses wherein the step of creating a pool is performed by a server (Figure 1 (12); page 5 [0082, 0083] *the server compares the entered search criteria to the candidate profiles stored in the candidate profile database 36. The server next lists candidates who match the entered search criteria (Fig. 4 (92)).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of the server performing the function of creating the pool as taught by Mayer with the disclosure of InoNet since the Internet is being used to match job candidates and employers with increasing frequency and the server cooperates to maintain the system and perform the method with increased efficiency and speed.

Regarding Claim 6:

InoNet does not disclose a method wherein the step of contacting subscribers is performed over the network.

However, Mayer discloses contacting subscribers (*candidates*) over the network (page 1 [0011] *candidate can be contacted by an email message, an instant message transmitted to the candidate's browser, an the like*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the contact teachings of Mayer with the disclosure of InoNet since

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an email or instant message would allow the candidates or subscribers to be notified of the match quicker and more efficiently than would be a notification sent by regular mail as a letter, or delivered by fax or phone.

Regarding Claim 8:

InoNet discloses a method wherein the step of providing a forum further comprises a step of providing at least one web page as the forum (InoNet is a website, *a virtual network of inventors using the intellectual power of the web to provide online problem solving sessions, this is the place for creativity, **collaboration** and collective magic;* page 1).

InoNet does not disclose the web page being stored on the server

However, Mayer discloses a web page stored on a server (page 2 [0023] and [0024], page 3 [0043-0045]).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Mayer with the disclosure of InoNet since the server cooperates to maintain the network system and perform the steps of the method and enables a candidate or an employer to interact with the server with one or more pre-formatted web pages.

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Regarding Claim 9:

InoNet discloses a method wherein the step of creating a subscriber list further comprises a step of:

contacting, by an individual using a computing device, a subscriber database (page 1, *join our databank of inventive people, Register Now (hyperlink)*);

creating a subscriber record for the individual on the subscriber database (pages 1 and 9-13, *once registered the subscriber joins the databank of inventive people*);

inputting, by the individual, information including a name of the individual, contact information of the individual, and qualifications of the individual into the subscriber record (page 9-13 *name, area of interest, company affiliation, academic affiliation, special expertise, working style, education*); and

storing the subscriber record on the subscriber database (page 1 *databank of inventive people, page 7 database of specialist*).

Regarding Claim 10:

InoNet does not disclose a method wherein the step of creating a subscriber list comprises establishing non-subscriber criteria; using said non-subscriber criteria to select individuals, creating non-subscriber records for said selected individuals, each of said non-subscriber records including information about a selected individual; and maintaining said non-subscriber records on a non-subscriber database.

However, Mayer discloses a method wherein the step of creating a subscriber list comprises establishing criteria (page 5 [0080, 0081] *employer submits job profile data and search criteria at web site hosted by server 12*); using the criteria to select individuals candidates (page 5 [0082] *the server then compares the entered search criteria to the candidate profiles stored in candidate profile database*), creating records for said selected individuals including information about a selected individual (*candidate profile* Figure 4); and maintaining the records in a database (page 3 [0037] *candidate profile database (36)*).

Mayer does not disclose that the candidates are non-subscribers. However, the type of candidates is determined to be non-functional descriptive data. Nonfunctional descriptive data cannot render non-obvious an invention that would have otherwise been obvious. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The steps of creating the list by matching criteria would be performed the same regardless of the type candidate.

Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of Mayer with the disclosure of InoNet since the Internet is being used to match job candidates and employers with increasing frequency and the system allows an employer to search profile data corresponding to a plurality of candidates, thus expanding the search, and return results corresponding to candidates who match the search criteria with increased efficiency and speed, as opposed to a manual search.

Regarding Claim 11:

Mayer discloses adding individuals (*candidates*) to the created pool of co-inventors by searching said database for candidates that match desired qualifications (Page 5 [0080-0083]).

Regarding Claims 12 and 13:

Both InoNet and Mayer disclose a databank of inventive people (InoNet page 1) and candidate profile database (Mayer Fig. 2B (36)). Mayer and Inonet further disclose information such as contact information, employment type, education, and background data (InoNet pages 9-13, Mayer pages 3-4 [0047-0054] and page 5 [[0065-0074])

Neither InoNet or Mayer disclose a record including a confidentiality/access level or a method wherein the confidentiality level is used to eliminate a subscriber.

However, the confidentiality level would be a qualification or criteria by which the match is performed. Since the confidentiality level is a qualification or criteria by which the match is performed, the steps of matching the criteria with the qualifications would be performed the same regardless of what type information was entered as a qualification or criteria.

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Therefore, it would be obvious to incorporate into the teaching and disclosure of InoNet and Mayer a field on the registration page or pre-formatted web page which allowed confidentiality information to be entered since intellectual property is an asset that is protected by companies and inventors and a company would not want to risk losing the potential asset to a competing company by allowing access to the information to someone who is not trustworthy, thus this person would be eliminated by the system since his/her confidentiality level would not match the criteria/qualifications necessary to make the list of potential candidates or inventors.

Regarding Claim 49:

InoNet discloses a method further comprising submitting a registration form to be included in databank of inventive people. InoNet does not disclose obtaining fees by a fee collection system.

However, Mayer discloses obtaining fees by a fee collection system as shown in Figure 4 where the employer pays to unlock candidate identification and page 3 [0042] which identifies the web site host charging fees.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include obtaining fees as taught by Mayer with the disclosure of InoNet so as to generate revenue to run the job-placement web site business.

Regarding Claim 50:

InfoNet discloses a website for inventors which creates a pool of co-inventors (page 4 *from its database, InoNet chooses a group of 8-10 inventors*).

InfoNet does not disclose a fee collection system in which a fee is obtained from the initial inventor/company entitling the inventor to obtain information concerning the pool of potential co-inventors.

However, Mayer discloses the employer paying a fee to unlock the identification and contact data of the candidates (page 5 [0084])

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the payment of fees by the employer as taught by Mayer with the disclosure of InoNet so as to generate revenue on the basis of the number of qualified candidates that employers actually find through the use of the web site rather than charging for all candidates that match a particular job description so more employers will continue to use a job placement web site since the amount of money they are

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charged is proportional to the number of suitable and desirable candidates that the employer finds through the web site.

Regarding Claim 51:

InoNet discloses a method further comprising the step of :

using a subscriber criteria (page 8 *InoNet, in cooperation with the client company selects potential team members*) supplied by the corporation (page 6 *corporate R&D, page 7 Who uses the service? Medium to large corporations*) and creating a pool of co-inventors (page 8 *after scanning a database of inventive people, a diverse team is assembled, page 4 from its database, InoNet chooses a group of 8 to 10 inventors*).

InoNet does not disclose obtaining a fee.

However, Mayer discloses a fee being paid (page 5 [0084] *employer pay a fee to unlock identification and contact data*) and a web site host capable of charging further fees (page 3 [0042]).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine obtaining fees as taught by Mayer with InoNet since Mayer states there is a need for an interactive employment system and method which generates revenue on the bases of the number of qualified candidates that employers find through the use of a job-placement website.

Mayer discloses submitting job profile data [0080]. InoNet discloses the client company providing a full, confidential description of the problem to be solved. Neither discloses qualifications for a candidate to include drafting hours, proposals, drafts, and issued patents. However, parties/employers looking for candidates generally list qualifications in the field of their endeavor hoping to find the most qualified match. The more explicit the qualifications the more probable that the match a closer match will be achieved. For example, the qualifications listed for a doctor or a chef would be different than the qualifications listed for a mechanic. The qualifications for a pediatrician would be different from the qualifications listed for a surgeon. Therefore, a party looking for a person in the medical field would indicate the desired qualifications relating to a doctor, nurse, etc. If the party is looking specifically for a pediatric nurse, not a doctor, the party must submit as search criteria the qualifications that one would look for in a pediatric nurse. Thus, a party interested in developing a patent application would list qualifications pertinent to the field of intellectual property, more specifically, submitting and prosecuting a patent application.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the candidate/inventor match disclosed in InoNet and Mayer a list of qualifications including information about a candidates background and experience relating to patents since common sense dictates that a person who has hours of experience in drafting a patent application or who has actually gone through

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the process of having a patent issued will be more effective and efficient as a co-inventor/employee.

11. Claim 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over InoNet and Meyer as applied to claim 1 and further in view of Tayadon et al (US 6,564,246) (hereinafter referred to as Tayadon).

Referring to Claim 88:

Neither InoNet nor Mayer disclose determining a confidentiality/access level for the proposal or wherein information is provided in the forum according to a level of confidentiality/access.

However, Tadayon discloses a distributed file system which allows access to files by remote authorized users by using predetermined rules that enable the active virtual file system to be used in workflow automation [0012] which has an "Access Rights" function which inspects information previously store pertaining to this particular user (which could include a level of confidentiality) [0016] *the invention is specifically disclosed as a web-based active virtual file system that controls the access rights of users to files stored on the server [0006] once the user has been authenticated, the file system 50 will determine what access rights this particular user will have [0070-0071] as in conventional network servers, virtually the first thing that must occur when a user initially communicates to a distributed file system is to determine whether or not the user has any right to be logged into the file system. Once the user has been property authenticated, this user's access rights must be determined and the WAVFS 150 uses*

an "Access Rights" function 162 for this purpose. The user's access rights are represented by information that has been stored in the WAVFS 150 pertaining to this particular user). The Examiner asserts that the information stored could encompass a confidentially level.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the problem solving service discloses in InoNet with the distributed file system access rights as taught in Tadayon to be able to monitor and control certain actions by users and to control the access rights of users to the files by determining whether or not the user has any right to be logged into the system and what rights the user has once authenticated.

12. Claim 82 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al (US 2001/0034630) (hereinafter referred to as Mayer) in view of InoNet and further in view of Tayadon.

Regarding Claim 82:

Mayer discloses computer system, the computer system comprising:

- at least one computer-readable memory including (Figure 2A (25), page 3 [0034-0037] *the memory 25 may be an internal or external large capacity device for storing computer processing instruction, computer-readable data, and the like, server 12 includes a processor 31 and a memory 35 which may store one or more operating system and application programs*):

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- code for maintaining a database structure of a list with records including a name, contact information, and qualifications (page 3 [0037] *server 12 stores a database program which maintains one or more databases, such as candidate profile database and job profile database*),
- code for searching for records in the list with qualifications matching a set of desired qualifications for the invention proposal (page 5 [0080-0083] *server then compares the entered search criteria to candidate profiles and lists candidates who match entered search criteria*) ,
- code for creating a pool from the records that match a set of desired qualifications ((page 5 [0080-0083] *server then compares the entered search criteria to candidate profiles and lists (pools) candidates who match entered search criteria*) ,

Mayer does not disclose:

- code that maintains a forum being accessible to the pool
- code for receiving a proposal for an invention, said proposal including a proposal.

However, InoNet discloses:

- code that maintains forum being accessible to the pool (page 4, *from the database of inventive people, InoNet chooses a group of 8-10 inventors (pool), page 1, this is a place for creativity, **collaboration** and collective magic, page 4 and page 7 – the problem solving sessions take place in a secure online environment (forum)*)

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- code for receiving a proposal for an invention (page 4 – *technology, product process or packaging problems* (proposal is the problem needing a solution) are submitted).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the collaborative and problem solving teachings of InoNet with the disclosure of Mayer since companies can no longer depend only upon in-house resources for answers to problems, they need a place where problems find solutions and innovators find a community of like-minded people to collaborate to solve complex problems, assemble a diverse team of highly qualified people for several disciplines and industries and tap into creative resources of inventors all over the world .

Neither InoNet nor Mayer disclose code for determining a confidentiality/access level for the proposal or wherein information is provided in the forum according to a level of confidentiality/access.

However, Tadayon discloses a distributed file system which allows access to files by remote authorized users by using predetermined rules that enable the active virtual file system to be used in workflow automation [0012] which has an "Access Rights" function which inspects information previously store pertaining to this particular user (which could include a level of confidentiality) [0016] ([0001] *the invention is specifically disclosed as a web-based active virtual file system that controls the access rights of users to files stored on the server [0006] once the user has been authenticated, the file*

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system 50 will determine what access rights this particular user will have [0070-0071] as in conventional network servers, virtually the first thing that must occur when a user initially communicates to a distributed file system is to determine whether or not the user has any right to be logged into the file system. Once the user has been properly authenticated, this user's access rights must be determined and the WAVFS 150 uses an "Access Rights" function 162 for this purpose. The user's access rights are represented by information that has been stored in the WAVFS 150 pertaining to this particular user). The Examiner asserts that the information stored could encompass a confidentially level.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the problem solving service discloses in InoNet with the distributed file system access rights as taught in Tadayon to be able to monitor and control certain actions by users and to control the access rights of users to the files by determining whether or not the user has any right to be logged into the system and what rights the user has once authenticated.

Mayer discloses submitting job profile data [0080]. InoNet discloses the client company providing a full, confidential description of the problem to be solved. Neither discloses qualifications for a candidate to include drafting hours, proposals, drafts, and issued patents. However, parties/employers looking for candidates generally list qualifications in the field of their endeavor hoping to find the most qualified match. The more explicit the qualifications the more probable that the match a closer match will be achieved. For example, the qualifications listed for a doctor or a chef would be different

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than the qualifications listed for a mechanic. The qualifications for a pediatrician would be different from the qualifications listed for a surgeon. Therefore, a party looking for a person in the medical field would indicate the desired qualifications relating to a doctor, nurse, etc. If the party is looking specifically for a pediatric nurse, not a doctor, the party must submit as search criteria the qualifications that one would look for in a pediatric nurse. Thus, a party interested in developing a patent application would list qualifications pertinent to the field of intellectual property, more specifically, submitting and prosecuting a patent application.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the candidate/inventor match disclosed in InoNet and Mayer a list of qualifications including information about a candidates background and experience relating to patents since common sense dictates that a person who has hours of experience in drafting a patent application or who has actually gone through the process of having a patent issued will be more effective and efficient as a co-inventor/employee.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over InoNet and Mayer as applied to claim 1 and InoNet and further in view of Eisenhart (2001/0047276) (hereinafter referred to as Eisenhart).

Regarding Claims 7 and 53:

Inonet does not explicitly disclose a server or each of the computing devices accessible by one or more subscribers in the pool.

However, Eisenhart discloses a method wherein the step of providing the forum (technology exchange and collaboration) is performed over the network by a server (Figure 2 (242) contributor server, page 3 [0035] (contributor is one contributing to the commercial development of the technology page 1 [0006]), each of said plurality of computing devices being accessible by one or more subscribers in the pool of co-inventors (contributors) (page 4 [0042])

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the server as taught in Eisenhart with the disclosure of InoNet so as to allow the contributor to use his/her computer and the connection between the server and the Internet to register with and access the technology exchange system.

14. Claim 89 is rejected under 35 U.S.C. 103(a) as being unpatentable over InoNet and Mayer as applied to claim 1 above, and further in view of Thomas et al (US 6,301,574) (hereinafter referred to as Thomas).

InoNet and Mayer disclose the method of claim 1. Neither InoNet nor Mayer disclose collecting bids or displaying information relating to the bids using at least one of a pie chart or a graph.

However, Thomas discloses collecting bids and displaying them in a table (abstract, Figure 2B (250, 260); col. 2, line 45 thru col. 3, line 2).

It would have been obvious to one of ordinary skill in the art to incorporate into the matching method of InoNet the ability to collect bids as disclosed in Thomas to

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provide competitive pricing which had been denied due to limited pool of contractors wherein the existence of a substantial pool provides the advantage of competitive cost.

How the information is displayed does not affect the steps of the method. It only means something in the mind of the observer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the information in many forms, whether in graphs or pie charts, since once the information is gathered the act of displaying the information does not impact on the steps of the method.

Response to Arguments

Applicant's arguments filed July 17, 2007 have been fully considered but they are not persuasive.

The Examiner has addressed the applicant's arguments in the body of the rejections. The Examiner notes that the applicant has provided no arguments as to the rejection of claim 89 under 35 USC 112, 2nd paragraph.

Applicant has also provided no arguments as to the prior art rejections with the exception of the declaration under 35 USC 1.131.

Conclusion

All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

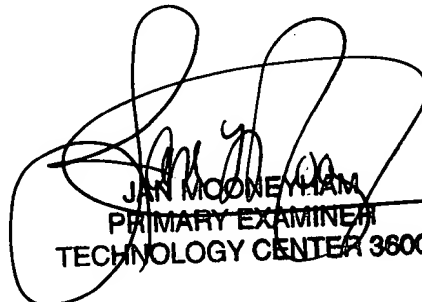
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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